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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/813,592
Filing Date: 03/21/2001
Applicant: Daniel J. Lubera et al.
Group Art Unit: 3677
Examiner: James R. Brittain
Title: RESILIENT CLIP FASTENER
Attorney Docket: 0275M-000320/CPA

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PETITION FROM REQUIREMENT FOR RESTRICTION

Sir:

Applicant hereby petitions, in accordance with 37 C.F.R. §1.144, to review requirement for restriction which was made final in the present application in an Office Action mailed February 27, 2006.

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REMARKS

The Office entered a restriction requirement, stating that the present application includes three patentably distinct species of the claimed invention. Applicant traversed the rejection and requested reconsideration of the entry of the Restriction Requirement. In the Office Action mailed February 27, 2006, the Office made the restriction requirement final. Applicant's petition for review of the restriction requirement has been filed with the Office within two months of the mailing of the February 27, 2006 Office Action and as such is timely filed pursuant to 37 CFR §1.181.

Applicant submits that the Office has not set forth a proper requirement for restriction. Applicant notes that Section 803 of the Manual of Patent Examining Procedure provides that "[there] are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed; and (B) There would be a serious burden on the examiner if restriction is not required." Moreover, Section 803 of the Manual of Patent Examining Procedure states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. (emphasis added)

Applicant further notes that the prior Examiner assigned to the present application did not enter a restriction requirement or an election of species requirement at any point during the rather lengthy prosecution of the present application, despite the fact that the application included claims to each of the three presently identified groups of inventions. Accordingly, Applicant submits that the issue of "serious burden" had been inherently decided by the prior Examiner in the negative. In this regard, Applicant

submits that as the prior Examiner did not enter a restriction requirement or election requirement, the prior Examiner inherently decided that Applicant's presentation of claims to each of the three presently identified groups of inventions was not a serious burden.

Applicant submits that as the Office must give full faith and credit to the actions of the prior Examiner (see, e.g., MPEP §704), the Office cannot now contend that the presentation of claims to the three presently identified groups of inventions is a serious burden. Applicant notes that the present Examiner has not addressed Applicant's "full faith and credit" argument, but rather has stated that he believes that the number of pending claims is a burden and merely substitutes his judgment for that of the prior Examiner.

Applicant notes that fewer claims are presently pending as compared to the number of claims that were pending in the application when the case was handled by the prior Examiner.

Furthermore, the present Examiner has stated that the Applicant has an allowed generic claim and that Applicant has an opportunity to reunite claims drawn to the non-elected species covered by the allowed generic claim. Applicant notes, however, that Claims 112-121 do not appear to be generic. Consequently, Applicant does not have an opportunity to reunite claims drawn to the non-elected species.

As such, Applicant respectfully submits that the final Restriction Requirement entered by the Office is improper and respectfully requests the Office to reconsider and withdraw the restriction requirement.

Prompt and favorable consideration of this correspondence is respectfully requested. If the Office believes that personal communication will expedite prosecution of this application, the Office is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: March 9, 2006

By: 
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MDZ/cr

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